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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
*EXPRESS*

Docket Number (Optional)

*OPE-1001CP2*

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on *Aug. 23, 2006*Signature *[Signature]*Typed or printed name *SHAWN HUNTER*

Application Number

*10/814,464*

Filed

*3/31/2004*

First Named Inventor

*RICHARD D. HAVN*

Art Unit

*3671*

Examiner

*TARA L. MAYO*

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record. *36,168*  
Registration number☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34

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*AUGUST 23, 2006*

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of *1* forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## **REASONS IN SUPPORT OF PRE-APPEAL BRIEF REVIEW REQUEST**

Applicant is filing this request for pre-appeal brief review because Applicant feels that the claim rejections at issue are clearly improper, and Applicant would like to avoid the necessity of having to file an appeal brief.

### **The Obviousness Rejections of Claims 1-3, 6, 9, and 14-16 are Improper**

Several of the claims at issue (1-3, 6, and 9 and 14-16) have been rejected for obviousness under 35 U.S.C. §103(a). The rejections of these claims hinge upon a combination of one of two references [Parsons (U.S. Patent No. 4,165,706) or Field (U.S. Patent No. 4,627,767)] with the Ulbrecht reference (U.S. Patent No. 3,507,242). The claimed subject matter relates to floating platforms that are used to hydrocarbon gas and solid hydrates. The relevant claim element at issue here relates to the circulation of a fluid of desired temperature within an environmental boundary surrounding a storage tank on the platform to control the temperature within the storage tank. The Examiner is using Ulbrecht to supply the teaching of "prior knowledge of flushing the space (i.e., an environmental boundary) between tank walls with inert gases to effect cooling . . . ." 2/21/2006 Office action at 4.

However, the combination of references is improper. Ulbrecht clearly teaches against this type of environmental cooling, which is precisely what the Examiner is relying upon Ulbrecht to teach. Applicant argued previously that Ulbrecht teaches that cooling by fluid circulation within a boundary is highly undesirable. See Applicant's Amendment of 3/16/2006 at 5-8. Ulbrecht describes concerns with safety, repair time and leaks with such systems. See Applicant's Amendment of 3/16/2006 at 6. Indeed, Ulbrecht's invention is an alternative type of tanker that does not use environmental boundary cooling so that the disadvantages associated with environmental boundary cooling are avoided. *Id.*

It is Applicant's position that, even though Ulbrecht might show "prior knowledge" of such environmental boundary cooling, one of skill in the art reading Ulbrecht would not be motivated to use that knowledge. The Examiner has suggested that the environmental boundary cooling described in Ulbrecht is a "non-preferred embodiment" upon which she is entitled to rely. 5/31/2006 office action at 8. If this were a rejection under 35 U.S.C. §102, Applicant would have to agree with the Examiner. See MPEP §2123 and citations. However, this is an obviousness rejection under §103, and a motivation or suggestion to combine or modify the references is essential to a prima facie rejection for obviousness. See MPEP §2103. In this case, there are no suggestions or teachings in the art to modify either Field or Parsons to use the environmental boundary cooling shown in Ulbrecht, and the Examiner has never attempted to show any such teachings. The only suggestions found in the art, specifically in Ulbrecht, are to avoid environmental boundary cooling, and, therefore, this is a classic case of the art teaching directly against the combination proposed by the Examiner. Applicant submits that the rejection is clearly improper and should be removed.

#### **The Obviousness Rejections of Claims 10-13 are Improper**

Claims 10-13 have been rejected for obviousness over a combination of Field and Ulbrecht. See 2/21/2006 office action at 5-6. The Examiner considers Field to show "a plurality of storage vessels." Id. at 6. Applicant has argued below that the proposed combination does not reveal at least the element of a storage vessel for storage of a material of the group consisting of hydrocarbon gas and solid hydrocarbon hydrates. See 3/16/2006 Amendment at 8. The Examiner has argued that "the prior art storage vessels [of Ulbrecht] are 'useful for storage of hydrocarbon gas or hydrates' as recited in claim 10." 5/31/2006 office action at 8. She has also argued that the recitation of storing



hydrocarbon gases or hydrates is merely a recitation of intended use of the claimed invention and, that if the prior art structure is capable of performing the intended use, it meets the claim. Id. Applicant continues to maintain that there is no evidence or indication in the art that the storage vessels of Ulbrecht would be suitable for or capable of storing either hydrocarbon gases or solid hydrocarbon hydrates. 3/16/2006 Amendment at 8. In fact, the storage vessels shown in Ulbrecht are used to store liquids. Id. There is no evidence to show that these storage vessels have the pressure and temperature controls necessary to store either substance. All claim limitations must be taught or suggested. MPEP §2143.03. Because at least this element is not taught or suggested by the art of record, claims 10 and 11 should be deemed allowable.

### **Conclusion**

In an amendment filed via facsimile on August 17, 2006, Applicant corrected the objection to claim 1 that was noted in the May 31, 2006 final office action. Thus, the resolution of the issues listed above should be dispositive of this case.

Applicant respectfully requests that the pre-appeal brief panel conclude that the claims of the present application are allowable.

Respectfully submitted,

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